RESPONSE AND REMARKS

CLAIM REJECTIONS UNDER SECTION 103(a)

In the Office Action, Claims 1-10, 19-21, 60-65 and 100-102 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab et al. (U.S. Patent Application Publication No. U.S. 2002/0019777; "*Schwab*") in view of Siegel (U.S. Patent Application Publication No. U.S. 2004/0143519; "*Siegel*"), Junger (U.S. Patent No. 6,269,344, "*Junger*") and Kara (U.S. Patent No. 6,233,568, "*Kara*"). *Office Action*, Topic Nos. 3-10, pgs. 3-6.

The Office Action failed to state grounds for rejecting Claims 10-12, 27, 62-65, 103, and 138-141. With respect to Claims 10-12, 27, 62-65, 103, and 138-141, the Office Action states only that "[w]ith respect to Claims 10-12, 27, 62-65, 103, and 138-141: See Kara, Figure 8 with corresponding detailed description." *Office Action*, Topic No. 8, p. 6.

Even though the Office Action failed to state grounds for rejecting Claims 10-12, 27, 62-65, 103, and 138-141, the Office Action rejected Claims 13-21, 27, and 65 "under 35 U.S.C. §103(a) as being unpatentable over Schwab, Siegel, Junger and Kara as applied to Claim 11 above, and further in view of UPS® Service Guide (www.ups.com) ["*UPS*"] and FedEx® Services (www.fedex.com) ["*FedEx*"] and Barnett et al. (U.S. Patent No. 6,369,840; "*Barnett*"). *Office Action*, Topic No. 11, p. 6.

RESPONSE REMARKS REGARDING CLAIM REJECTIONS UNDER SECTION 103(a)

The rejections of the Claims have been carefully considered. Previously Withdrawn Claims 22-26, 28-59, 66-99, 104-137, and 142-169 have been cancelled to place the application in condition for allowance. Claims 1, 27, 62, 65, 100, 103, 138 and 141 have been amended to more distinctly claim the claimed invention.

A Declaration is filed herewith under 35 U.S.C. §132 by David Allison Bennett, currently with iShip Inc. (a fully owned subsidiary of United Parcel Service of America, Inc., which is a fully owned subsidiary of United Parcel Service, Inc.), one of the assignees of the above-identified patent application ("*Bennett Declaration*" or "*Bennett Decl.*").

It is respectfully asserted, for the reasons given and authorities cited below, and in view of the evidence of nonobviousness provided by the concurrently filed _Bennett Declaration_, that the application is in condition for allowance.

The Office Action Has Failed to Establish a Prima Facie Case of Obviousness for Claims 10-12, 27, 62-64, 103, and 138-141

It is respectfully asserted that the Examiner has not identified how any of the references of record disclose the limitations recited in Claims 10-12, 27, 62-65, 103, and 138-141. Accordingly, the Applicants respectfully request withdrawal of these rejections.

The References of Record Fail to Disclose, and the Office Action Fails to Cite Any Reference That Discloses, a Display to a Consumer of a Set of Carriers That Were Pre-Selected by a Merchant From a List of Available Carriers for Subsequent Use by the Consumer for a Shipment by the Consumer to the Merchant of a Returnable Item

It is respectfully submitted that the Office Action fails to identify any reference or combination of references that disclose the limitations claimed in one way or another by independent Claims 1, 27, 62, 65, 100, 103, 138, and 141, as amended, for displaying, or generating a display, to a consumer of a set of carriers [and in some cases, services] that have been pre-selected by a merchant from a list of available carriers [and in some cases, services] for subsequent selection and use by the consumer in return shipping of an item of merchandise that the consumer had purchased from the merchant.

In particular, independent Claim 1 recites a merchant-selected display of carriers to a consumer as follows:

> if the particular respective item of merchandise is returnable, generate a display to the consumer comprising information _corresponding to a set of carriers that was pre-selected by the particular online merchant from a list of available carriers for use by the consumer for a return shipping of the particular respective item of merchandise to the particular online merchant._

Independent Claim 27 similarly recites a merchant-selected display of carriers to

a consumer as follows:

> ... wherein the set of carriers and the set of services are selected by the computer system for display *according to a set of carriers that was pre-selected by the merchant from a list of available carriers* and according to a set of return policy rules input by the merchant, and wherein each respective shipping rate is calculated by the computer system according to information about the at least one item of merchandise that is accessible by the computer system;

Similarly, independent Claim 62 recites a merchant-selected display of carriers to a consumer as follows:

> collecting a set of return policy rules input by a merchant comprising an identification by the merchant of a set of carriers that may be used by a consumer for shipping an item of merchandise, *the set of carriers being selected by the merchant from a list of available carriers*; ...and
>
> in response to [a] merchandise return request, generating a display to the consumer of the set of carriers identified by the merchant according to the return policy rules for use by the consumer for shipping the particular item of merchandise to the merchant.

It is further respectfully submitted that, in one way or another, independent Claims 65, 100, 103, 138 and 141 similarly recite a merchant-selected display of carriers to a consumer.

In rejecting Claims 1-9, 19-21, 60-65 and 100-102, the Office Action conceded that *Schwab*, *Siegel* and *Junger* "... fail to disclose[] displaying multiple carriers for use by the user to ship the item to the merchant." *Office Action*, Topic No. 7, p. 5.

However, in order to compensate for the conceded failure of *Schwab*, *Siegel* and *Junger*, the Office Action posits that *Kara* "... discloses the use of a system used to select a carrier for shipment and calculating shipping rates for a plurality of carriers ...." *Office Action*, Topic No. 7, p. 5. The Office Action then concludes that "[i]t would have been obvious ... to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers, according to Kara, in order ... for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract)." *Office Action*, Topic No. 7, p. 5.

It is respectfully asserted that *Kara* fails to disclose the combination of limitations claimed in one way or another by amended independent Claims 1, 27, 62, 65, 100, 103,

138, and 141 for displaying, or generating a display, to a consumer including a subset of carriers that have been pre-selected by the merchant from a list of available carriers for use by the consumer. In particular, it is respectfully asserted that _Kara_'s disclosure of shipping rates for a plurality of carriers comprises only a static, system-defined list of carriers. It is respectfully asserted that there is no disclosure in _Kara_ that the carriers that appear in the static _Kara_-system-defined list of carriers were pre-selected by a merchant from a list of available carriers to appear in the _Kara_-system-defined list.

In response to the above-mentioned arguments, the Office Action instead asserts that "... all of the method steps are known in Scwab [sic], Siegal [sic], Junger and Kara. The only difference is the combination of 'old steps' into one method of returning and allowing the user to choose the carrier. Thus, it would have been obvious to one having ordinary skill in the art to display the carriers to the user as taught by Kara, in the return method of Schwab, Siegal [sic] and Junger, since the method of displaying multiple carriers which can be used to ship the return, is used to achieve predictable results of giving the user a choice." _Office Action_, Topic No. 7, p. 5 (citing "... KSR [127 S Ct. at 1739] 'The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.'....").

It is respectfully asserted that the above-asserted position fails to identify a single reference of record that discloses "... generat[ing] a display to the consumer comprising information _corresponding to a set of carriers that was pre-selected by the particular online merchant from a list of available carriers_ for use by the consumer for a return shipping of the particular respective item of merchandise to the particular online merchant ..." as claimed for example, by Claim 1 (emphasis added). _See also_, independent Claims 27, 62, 65, 100, 103, 138, and 141 for similar limitations. As noted above, _Kara_ merely discloses a static, system-defined list of carriers rather than a list that has been pre-selected by a merchant from a list of available carriers.

"[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. ... Instead, the claim as a whole must be considered." _Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility_, (United States Patent and Trademark Office; _Official Gazette_ Notices for November 22, 2005), §

II.C (citing _Diamond v. Diehr_, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)).

The amended claim language of Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying a list of carriers to a consumer/user that has been pre-selected by a merchant is supported by the disclosure of the Specification of the present application, with respect to various exemplary embodiments, as follows:

> The Return Policy Engine component of the computer System embodying the present invention provides each of a plurality of online eCommerce Merchants with a User Interface ("UI") with which each eCommerce Merchant can, among other things: ... authorize return shipping options, selected by the Merchant from a plurality of services offered by a plurality of carriers, to which the Merchant's consumers will be given access by the System ....

Specification, p. 13, lines 21-29.

The Specification of the present application further discloses, with respect to various exemplary embodiments:

> Using the Return Shipping Options Screen as depicted in FIG. 12, the Merchant/User defines Online Shipping Options 185. If the Merchant agrees to pay for shipping returns, the Merchant/User checks the Merchant Pays option 186 and selects the shipping carriers and service options 187-1 through 190 for which the Merchant will agree to pay.

Specification, p. 25, lines 14-17.

Yet further, for the following reasons, it is respectfully asserted that amended Claims 1, 27, 62, 65, 100, 103, 138, and 141 claiming displaying a list of carriers to a consumer/user that has been pre-selected by a merchant is non-obvious in view of, and useful over, the references of record. In particular, it is respectfully asserted that the holding in _KSR_ does not condone an assertion of obviousness where, as here, some of the claimed elements have not even been shown to be disclosed by the references of record. Rather, "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements ...." _KSR_, 127 S.Ct. at 1741 (quoting with approval, _In re Kahn_, 441 F.3d 977, 988 (CA Fed. 2006)).

In _KSR_, the Supreme Court acknowledged that "... inventions in most, if not all, instances, rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known."

- 17 -

KSR, 127 S.Ct. at 1741. Accordingly, the *KSR* Court reiterated its caution against hindsight bias and *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. *Accord Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 2008 U.S. App. LEXIS 6786, *14-*15 (Fed. Cir. March 31, 2008) (explaining that "a flexible TSM [teaching, suggestion, or motivation] test remains the primary guarantor against a non-statutory hindsight analysis ...."(citations omitted)).

Yet further, "... a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR*, 127 S.Ct. at 1741.

As compared to the static, *Kara*-system-defined list of carriers, it is respectfully asserted that various embodiments of the combination of limitations claimed by Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display, to a consumer of carriers according to a pre-selection by a merchant for subsequent use by the consumer in shipping a return of an item to the merchant are distinguished from, patentable over, and would be useful over, *Schwab*, *Siegel*, *Junger*, *Kara* and the other references of record, in that providing a Merchant with the ability to customize the list of available carriers [and delivery services] for customer shipping of returns, would allow the Merchant to assert control over return shipping quality and costs. Moreover, it is respectfully asserted that such abilities for a Merchant to customize the list of available carriers [and delivery services] for customer shipping of returns, and to control return shipping quality and costs are features not provided by *Schwab*, *Siegel*, *Junger*, or *Kara*, whether considered alone or in combination with any of the other references of record.

Accordingly, in light of the above-explained proper interpretation of the claimed limitations, in view of the complete absence of those limitations from any of the references of record, in accordance with the caution by the *KSR* Court against hindsight bias and *ex post* reasoning (*KSR*, 127 S.Ct. at 1742), and further in view of the mandate by the *Interim Guidelines* to consider every limitation of a claim as a whole, it is respectfully asserted that various embodiments of the combination of limitations claimed by Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display,

to a consumer of carriers according to a pre-selection by a merchant for subsequent use by the consumer in shipping a return of an item to the merchant is distinguished from, is nonobvious in view of, and is patentable over, the references of record, and that those Claims and the Claims dependent on them are therefore in condition for allowance.

An Online Retail System's Display of Potentially Returnable Items Comprising Shipped Items Purchased Through the Online Retail System is Patentably Distinct From the References of Record that Appear to Require a Customer to Either Physically or Electronically, Address or Appear at a Site Other Than the Website Through Which the Customer Purchased the Item to be Returned

For the reasons described in more detail below, it is respectfully asserted that a particular online retail system's display of potentially returnable items comprising shipped items purchased through the particular online retail system as claimed by independent Claim 1 is patentably distinct from the references of record, including *Schwab*, *Siegel*, and *Junger* that appear to require a customer to either physically (in the cases of *Schwab* and *Junger*) or electronically (in the case of *Siegel*) turn to a physical location or website other than the website through which the customer purchased an item to be returned.

As distinguished from the references of record, it is respectfully asserted that various embodiments of the limitations of Claim 1 of the present application, for example, would allow a consumer to input a merchandise return request into the same online retail computer system through which the consumer had purchased the item to be returned. In particular, Claim 1 recites:

> receive through an online retail computer system of a particular online merchant, an indication of a shipment of an at least one item of merchandise purchased by a consumer through the online retail computer system;
> in response to the indication of shipment, designate through the online retail computer system, the at least one item as a potentially returnable item;
> receive through the online retail computer system a request by the consumer for an identification of potentially returnable items;

in response to the request, generate a display through the online retail computer system to the consumer of the identification of potentially returnable items, wherein the identification of potentially returnable items comprises an identification of the at least one item of merchandise, and further comprises a respective interactive means associated with each respective item of merchandise identified in the identification of potentially returnable items, wherein each respective interactive means is adapted for designating a return of each respective item of merchandise identified in the identification of potentially returnable items ....

As compared to allowing a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system, it is respectfully asserted that *Schwab* discloses a consumer having to deliver the item and a document (a "ReturnCERT 501") to a local return agent. *See, e.g., Schwab*, Paragraph 0052.

As compared to the above-identified combination of limitations recited, for example, by Claim 1 of the present application, it is respectfully asserted that, according to *Siegel*, in order for a user of *Siegel* to view the *Siegel* listing of a particular purchase, the user would need to have previously made the purchase through another website, namely, through the website of an online merchant (*see, e.g., Siegel*, ¶0026 ("The server system adds transaction listing 101 and detailed item description 104 to each web page for the item(s) the user has purchased from various retailers."); *see also, e.g.*, FIG. 1A), and would then subsequently need to log in to the *Siegel* website, not the website from which the relevant purchase had been made, in order to view the *Siegel* listing of purchases made by the user from various retailers and in order to arrange for a return of the item. *See, e.g., Siegel*, ¶0008 ("the method preferably includes identifying a user, gathering a transaction history associated with the identified user and displaying the transaction history associated with the identified user").

The Office Action does not disagree, conceding that "Schwab and Siegal [sic] ... fails [sic] to disclose it being through the online retail computer system ...." *Office Action*, Topic No. 6, p. 4. However, in an effort to compensate for the conceded failures of *Schwab* and *Siegel*, the Office Action asserts that "Junger discloses the use of a return system at a local site, then this information is sent to a remote approval computer

system for authorization of the return (Column 2, lines 46-67)." *Office Action*, Topic No. 6, pgs. 4-5. The Office Action then asserts that "[b]ecause ... Schwab and Siegal [sic] and Junger teach methods for returning purchased items, it would have been obvious ... to substitute one method for the other to achieve the predictably result of returning an item to a retailer." *Office Action*, Topic No. 6, p. 5 (citing the 2007 *KSR Int'l v. Teleflex* decision by the Supreme Court).

It is respectfully asserted that *Junger* does not add anything to the combination of references. *Junger* discloses, with reference to its FIG. 1, that "a regional warehouse 1 operated by a large retail chain collects product returns from local retail stores 3A and 3B." *Junger*, col. 3, lines 48-50. In *Junger*, "[a]fter the returned products arrive at the regional warehouse 1, they are sorted by manufacturer and/or product, and are shipped from the regional warehouse 1 to the manufacturer warehouse 5 for credit or replacement." *Junger*, col. 3, lines 61-64. According to *Junger*, "[e]ach step of the foregoing example return process involves various processing and handling requirements. For example, personnel at the local retail store must first review the product for compliance with applicable return requirements ... and then arrange for shipment to the appropriate regional warehouse ...." *Junger*, col. 4, lines 1-8. According to *Junger*, the *Junger* system "... may be utilized ... in connection with operations at the retailer regional return center warehouse 1 ...." *Junger*, col. 4, lines 24-26.

That is, in *Junger*, like *Schwab*, the user must have already delivered the returned item to a physical return location, such as a local retail store. Accordingly, it is respectfully asserted that *Junger* does not allow a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system as claimed by independent Claim 1.

Applicants respectfully disagree with the above-quoted assertion by the Office Action of obviousness because, among other things, the Office Action fails to assert a single reference of record that discloses, anticipates, teaches or suggests allowing a consumer that had purchased an item of merchandise through a particular online retail

computer system to input a merchandise return request into the same online retail computer system as claimed by independent Claim 1.

Further, contrary to the inference by the Office Action that _KSR_ supports the reasoning of the rejections of Claim 1, it is respectfully asserted that the holding in _KSR_ does not condone an assertion of obviousness where, as here, some of the claimed elements have not even been shown to be disclosed by the references of record. _See, e.g., KSR_, 127 S.Ct. at 1741-1742 (quoting _In re Kahn_ that "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements ...." (quoting with approval, _In re Kahn_, 441 F.3d 977, 988 (CA Fed. 2006)), acknowledging that "... inventions in most, if not all, instances, rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known..." and reiterating its caution against hindsight bias and _ex post_ reasoning).

Accordingly, in view of the complete absence of the above-mentioned claimed limitations from any of the references of record, in accordance with the caution by the _KSR_ Court against hindsight bias and _ex post_ reasoning (_KSR_, 127 S.Ct. at 1742), and further in view of the mandate by the _Interim Guidelines_ to consider every limitation of a claim as a whole, it is respectfully asserted that various embodiments of the combination of limitations claimed by Claim 1 is nonobvious in view of, and is patentable over, the references of record, and that those Claims and the Claims dependent on them are therefore in condition for allowance.

For the above-given reasons and under the above-cited authorities, because it is respectfully asserted that independent Claim 1 is patentably distinct from and patentable over the references of record, it is therefore respectfully asserted that the Claims that are dependent on Claim 1, namely, Claims 2-21, are therefore also patentably distinct from and patentable over the references of record.

None of the References of Record Disclose, and the Office Action Fails to Cite any References that Disclose, a Display Through an Online Merchant's Retail Computer System of an Identification of Potentially Returnable Items Comprising _Shipped_ Items that were Purchased by a Consumer Through the Online Merchant's Retail Computer System in that the References of Record Appear to Generate as Lists of Returnable Items, Items That Were Purchased, but Not Necessarily Shipped

It is respectfully asserted that none of the references of record, including _Schwab_ and _Siegel_, whether considered alone or in combination, disclose, anticipate, teach or suggest the combination of limitations of independent Claim 1 for "...generat[ing] ... a display ... of [an] identification of potentially returnable items compris[ing] an identification of [an] at least one item of merchandise [that was purchased by the consumer through the online retail computer system and _shipped_] ...."

The Office Action asserts that even though _Schwab_ "... fails to disclose the use of a display, which displays each item of a previous order and an interactive means associated with each item in each order, to return an item ... Siegel discloses a return system where a user's previous orders along with each item in the order are displayed, and each item is associated with a checkbox, which the examiner considers to be an interactive means, to submit a return request ...." _Office Action_, Topic No. 5, p. 4 (citing Figure 1A of _Siegel_ and the "corresponding detailed description").

However, as compared to the above-recited limitations claimed by Claim 1, it is respectfully asserted, for the reasons described further below, that a computer system such as claimed by Claim 1 that lists as potentially returnable, items that have already been shipped, is patentably distinct from, and patentable over, a system such as is asserted by the Office Action as disclosed in _Siegel_ that only lists items that have been _purchased_, by not necessarily shipped. _See, e.g., Siegel_, ¶[0008] and ¶[0026] (disclosing a system that gathers from various retailer systems/databases information about purchase transactions by a user); _Siegel_, FIG. 2, element 215 ("Transaction Database"); _Siegel_, FIG. 5, element 535 ("Gather Transaction History for User"); _Siegel_, ¶0045. _Siegel_ explains that the transactions are gathered from a collection of

databases for multiple retailers and other sources. _Siegel_, ¶0045 ("... transactions database 215 can be maintained at another location as well as created real-time from a collection of databases located at member retail sites, credit card sites or other data bases."); _see also, e.g., Siegel_, ¶0008 ("the method preferably includes identifying a user, gathering a transaction history associated with the identified user and displaying the transaction history associated with the identified user").

When a user accesses the _Siegel_ system, the _Siegel_ system presents a list of purchase transactions by the user gathered from various retailer databases and systems. _See, e.g., Siegel_, ¶[0008] and ¶0026]. However, it is respectfully asserted that there is no disclosure in _Siegel_ regarding whether the _Siegel_-presented items purchased by the user have been shipped. _See also Bennett Decl._, ¶ 8. It is therefore respectfully asserted that _Siegel_ does not disclose differentiating between items that have been purchased, but not yet shipped, and items that have been purchased and shipped to the user. _See also Bennett Decl._, ¶ 9.

Therefore, it is respectfully asserted that a _Siegel_ listing for a particular user may contain both items that have been purchased but not yet shipped (and therefore not yet received by the user, and therefore, that are not yet return shippable), as well as items that have been purchased and shipped to the user. _See also Bennett Decl._, ¶ 9. It is therefore respectfully asserted that a user of a _Siegel_ display of a listing of an item that has not yet been shipped could incorrectly select such an item for return. _See also Bennett Decl._, ¶ 9.

In order to discuss the types of issues that could result from such an incorrect selection, it may be helpful to consider a period of time during which a user may be involved in a relatively high number of purchases, such as, for example, during Christmas. During high transaction activity periods, a user may make repeated purchase of a same or similar item. _See also Bennett Decl._, ¶ 10. A user may receive one such item and want to return it. However, the corresponding _Siegel_ display would list the item that the user had already received as well as other item(s) of the same or similar type that the user had purchased but had not yet been received, or that, perhaps, had been shipped to others. _See also Bennett Decl._, ¶ 10.

Presented with such a list that co-mingles both shipped and not-yet-shipped items, it is respectfully asserted that the _Siegel_ user may indicate return of an item that was not yet been shipped by mistake. _See also Bennett Decl._, ¶ 10. It is respectfully asserted that, for items that may have a perishable life, for example, such an erroneous "return" could result in improper return processing by the merchant. _See also Bennett Decl._, ¶¶ 10-12. For example, such an erroneous return could require an additional reconciliation action by the merchant to correct what was expected to be returned, to what was actually returned. See, e.g., _Bennett Decl._, ¶ 11. Or, as another example, such an erroneous return could result in mistakenly allowing return of an already expired, perishable item, and could consequently result in a loss of money for the merchant. See, e.g., _Bennett Decl._, ¶ 12.

Claim 1 recites designating items that have been shipped, not merely purchased, as potentially returnable items. It is respectfully asserted that various embodiments of the limitations of Claim 1 would be useful over the _Siegel_ system in that only shipped items would be listed as potentially returnable, thereby preventing possibly confusing listings of items purchased but not yet shipped as potentially returnable, as would be possible under _Siegel_. _See also Bennett Decl._, ¶ 13. It is therefore respectfully asserted that Claim 1 is nonobvious in view of, and patentable over, the references of record.

For the above-given reasons, because it is respectfully asserted that independent Claim 1 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 1, namely, Claims 2-21, are therefore also patentably distinct from, and patentable over, the references of record, and are therefore in condition for allowance.

None of the References of Record Disclose, and the Office Action Fails to Cite any References that Disclose, Generating a Graphic User Interface for Input of Return Policy Rules and That is Adapted for Receiving Input Identifying at Least One Item as an Exception to Standard Return Policy Rules as Claimed by Claim 100

It is respectfully asserted that the limitations claimed by independent Claim 100 are patentably distinct from the references of record. In particular, Claim 100 recites:

> generating a graphic user interface for input of return policy rules, wherein the graphic user interface is adapted for receiving input identifying an item as an exception to standard return policy rules;
> collecting a set of return policy rules input by a merchant using the graphic user interface, wherein the set of return policy rules comprises an identification of at least one item as a policy rule exception, and wherein the set of return policy rules further comprises an identification by the merchant of a set of carriers and delivery services offered by each carrier of the set of carriers selected by the merchant from a list of available carriers and a list of available delivery services, said set of carriers and delivery services for subsequent selection by a consumer for use by the consumer to ship a return of merchandise ....

It is respectfully asserted that neither *Schwab*, nor any of the other references of record, disclose, anticipate, teach or suggest the recitation of Claim 100 of the limitation for "...generating a graphic user interface for input of return policy rules, wherein the graphic user interface is adapted for receiving input identifying an item as an exception to standard return policy rules...".

The Office Action cites *Schwab* as disclosing "... the use of a set of return questions ... and processing the return according to the rules ...." *Office Action*, Topic No. 4f, p. 4 (citing paragraphs [0012] and [0053] of *Schwab*).

Notwithstanding the assertions by the Office Action, Applicants respectfully disagree that *Schwab* discloses, or that the Office Action has cited a reference that discloses, generating a graphic user interface as claimed by Claim 100 or collecting a set of return policy rules input as claimed by Claim 100. Paragraph [0012] of *Schwab* cited by the Office Action describes in pertinent part a:

> ... second stage called parameterization, [that] allows the third party to review parameters defined by the merchant ... that establishes the conditions for an acceptable return. This can include, but is not limited to, physical descriptions of

the goods, quantity counts, packaging, general return policies, re-stocking fees, date of original purchase, warranties, acceptable physical condition, return window (dates) and any other data that enables the third party to act for the merchant in establishing whether or not the merchandise to be returned meets the conditions established for the return and may be accepted as a return. ... The parameterization process is accomplished by the third party reviewing material supplied by the merchant seller electronically via the electronic link established in the authentication stage described above.

Paragraph [0053] of _Schwab_ cited by the Office Action describes in pertinent part that:

At this point, where the return request appears valid, the third party 60 would initiate a Parameter Request 605 utilizing his computer system 603, which is electronically connected to the merchant 40. The merchant 40 would then automatically provide the Return Parameters 607 back to the third party 60. These parameters or conditions for the return 607 are then reviewed by the third party 60 and the product return 503 is compared to the parameters 607 provided by the merchant 40. If the product 503 and ReturnCERT 501 satisfies the Return Parameters 607 specified, the third party 60 initiates a Parameters Accepted 609 communication to the merchant 40. This step is referred to as Presentation, since it establishes the compilation and presentation of all parameters of interest to a merchant 40 regarding a product return request. Once the third party 60 provides this information to the merchant 40, along with his indication that the product 503 and ReturnCERT 501 comply with the return parameters 607, the merchant 40 must decide whether or not to accept the return request. This can either be done manually or through an automated or pre-established method.

It is respectfully submitted that the above-quoted disclosures of _Schwab_ fail to disclose generating a graphic user interface for input of return policy rules as claimed by Claim 100 or collecting a set of return policy rules input as claimed by Claim 100.

Further, it is respectfully submitted that the above-quoted disclosures of _Schwab_ fail to disclose a graphic user interface that is adapted for receiving input identifying an item as an exception to standard return policy rules. In particular, although Paragraph [0012] of _Schwab_ discloses parameters such as "physical descriptions of the goods, quantity counts, packaging, general return policies, re-stocking fees, date of original purchase, warranties, acceptable physical condition, return window (dates)," it does not disclose identifying items as exceptions to return policy rules.

in view of the mandate by the _Interim Guidelines_ to consider every limitation of a

claim as a whole, it is respectfully asserted that various embodiments of the combination of limitations claimed by Claim 100 would be useful over the references of record in that the claimed exception definition and processing would provide a merchant with the ability to establish general return rules for broad categories of merchandise and would allow them to designate certain items as exceptions to the general return rules.

For the above-given reasons, it is respectfully asserted that independent Claim 100 is patentably distinct from the references of record, and is therefore respectfully asserted that the Claims that are dependent on Claim 100, namely, Claims 101-102, are therefore also patentably distinct from the references of record.

None of the References of Record Disclose Return Policy Rules Comprising a Set of Return Questions as Claimed by Claims 2, 61 and 65

The Office Action cites _Schwab_ as disclosing "... the use of a set of return questions ... and processing the return according to the rules ...." _Office Action_, Topic No. 4f, p. 4 (citing paragraphs [0012] and [0053] of _Schwab_).

Applicants respectfully disagree that _Schwab_ discloses the use of a set of return questions as asserted by the Office Action. Paragraph [0012] of _Schwab_ cited by the Office Action describes in pertinent part a:

> ... second stage called parameterization, [that] allows the third party to review parameters defined by the merchant ... that establishes the conditions for an acceptable return. This can include, but is not limited to, physical descriptions of the goods, quantity counts, packaging, general return policies, re-stocking fees, date of original purchase, warranties, acceptable physical condition, return window (dates) and any other data that enables the third party to act for the merchant in establishing whether or not the merchandise to be returned meets the conditions established for the return and may be accepted as a return. ... The parameterization process is accomplished by the third party reviewing material supplied by the merchant seller electronically via the electronic link established in the authentication stage described above.

Paragraph [0053] of _Schwab_ cited by the Office Action describes in pertinent part that:

> At this point, where the return request appears valid, the third party 60 would initiate a Parameter Request 605 utilizing his computer system 603, which is electronically connected to the merchant 40. The merchant 40 would then

automatically provide the Return Parameters 607 back to the third party 60.
These parameters or conditions for the return 607 are then reviewed by the third
party 60 and the product return 503 is compared to the parameters 607 provided
by the merchant 40. If the product 503 and ReturnCERT 501 satisfies the Return
Parameters 607 specified, the third party 60 initiates a Parameters Accepted 609
communication to the merchant 40. This step is referred to as Presentation,
since it establishes the compilation and presentation of all parameters of interest
to a merchant 40 regarding a product return request. Once the third party 60
provides this information to the merchant 40, along with his indication that the
product 503 and ReturnCERT 501 comply with the return parameters 607, the
merchant 40 must decide whether or not to accept the return request. This can
either be done manually or through an automated or pre-established method.

Notwithstanding the above-quoted disclosures of _Schwab_, it is respectfully
asserted that the above-quoted disclosures of _Schwab_ fail to disclose, anticipate, teach
or suggest the recitation by _e.g._, Claims 61 and 65, of the limitations "… wherein [a
sub]set of [the] return policy rules [input by the merchant] comprises: a set of return
questions; and a set of anticipated return question responses corresponding to each of
said return questions…". _See also_ Claim 2 for similar limitations regarding return
questions.

The Specification of the present application supports the claimed limitations,
explaining, with respect to various exemplary embodiments, for example, that:

> Using the Return Questions/Responses Page, the Merchant/User defines return
> policy questions, circumstances in which the questions should be asked, possible
> answer choices, and corresponding responses. The Merchant/User defines a
> plurality of Questions,…. For each question, the Merchant/User defines a number
> of criteria, as illustrated as follows for Question 1 200.

Specification, p. 26, lines 14-19. The Specification of the present application further
explains, with respect to various exemplary embodiments, for example, that:

> … the three-dimensional Situation Response Matrix comprises:
> 1.) a first dimension defining a set of return questions, e.g., 234-1-a, 234-
> 2-a, … 234-xx-a;
> 2.) a second dimension defining, for each return question, a set of return
> question responses corresponding to the return question, e.g., responses 235-1-
> a and 235-2-a corresponding to question 234-1-a; return question responses
> 235-3-a, 235-4-a, and 235-5-a corresponding to question 234-2-a; and
> responses 235-6-a and 235-7-a corresponding to question 234-xx-a; and

3.) a third dimension defining, for each return question response for each return question, a set of instructions to the computer system corresponding to the return question response corresponding to the return question, for example, instructions 236-1-a and 236-2-a corresponding to response 235-1-a for question 234-1-a.

Specification, p. 30, lines 8-20. The Specification of the present application then further explains, with respect to various exemplary embodiments, for example, that:

> In the illustrative example for the exemplary embodiment depicted in FIGS. 13e-13h, the System displays the text 234-1-b of the first question 234-1-a from the set of return questions established by the merchant. The System receives the consumer's answer in response to that first question. The System then compares the consumer's answer to the first question with the set of return question responses corresponding to the first question until a match is found. The System then directs the computer system to execute each instruction in the set of instructions corresponding to the matching return question response.

Specification, p. 31, lines 6-12.

It is respectfully asserted that none of the references of record, including *Schwab*, disclose, anticipate, teach or suggest a subset of the return policy rules that are input by a merchant that comprises: a set of return questions for eventual presentation to a returning consumer; and a set of anticipated return question responses that correspond to each of the return questions that can be expected to be input by the returning consumer.

For the above-given reasons, it is respectfully asserted that Claims 61 and 65 are patentably distinct from, and patentable over, the references of record and are therefore in condition for allowance.

None of the References of Record Disclose, and the Office Action Fails to Cite any References that Disclose, Generating a Credit to a Credit Card Account in Response to a Return Request as Claimed by Claim 60

It is respectfully asserted that neither *Schwab*, nor any of the other cited references, disclose, anticipate, teach or suggest the limitations recited by Claim 60 of "...in response to receiving the indication of receipt by the merchant of the item of merchandise, generate a credit to the credit card account." Moreover, it is further

respectfully asserted that the Office Action fails to cite any references that disclose the above-quoted limitations recited by Claim 60.

Because the Office Action failed to cite any references that disclose the above-quoted limitations recited by Claim 60, it is respectfully requested that the rejection of Claim 60 be withdrawn. Further, for the above-given reasons, it is respectfully asserted that Claim 60 is patentably distinct from, and patentable over, the references of record, and that, therefore, the Claim that is dependent on Claim 60, namely, Claim 61, is also patentably distinct from, and patentable over, the references of record, and are therefore in condition for allowance.

None of the References of Record Disclose Generating a Display of an Interactive Graphic Comparison of Calculated Shipping Rates at the Intersection of Corresponding Delivery Dates and Times as Claimed by Claim 15

It is respectfully asserted that the combination of limitations recited by dependent Claim 15 (and the Claims on which it depends) is patentably distinct from, and patentable over, the references of record. In particular, dependent Claim 15 (and the Claims on which it depends) claims the generation of a display to a consumer of calculated shipping rates for carriers pre-identified by a merchant such that the rates are displayed at an intersection that coincides with a particular delivery date and a particular delivery time by which a particular delivery service by a particular carrier would deliver an item being returned by the consumer to a particular online merchant for the displayed shipping rate.

The Office Action concedes that *Kara* does not specifically disclose the rates being calculated with respect to time, but asserts that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day." *Office Action*, Topic No. 12, p. 6. The Office Action further asserts that "[i]t would have been obvious ... to include the time sensitive "urgency" services, as disclosed by FedEx® and UPS® , in order to ship thing [sic] and compete with a time advantage

using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1)." _Office Action_, Topic No. 12, p. 6.

The Office Action further concedes that "Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services, where one axis being date and one axis being time and where each cell is located at the intersection of the date and time." _Office Action_, Topic No. 12, p. 6. The Office Action then asserts, though, that "Barnet [sic] discloses the use of a calendar which can be [used] for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9)." _Office Action_, Topic No. 12, pgs. 7. The Office Action concludes that "[i]t would have been obvious ... to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2)." _Office Action_, Topic No. 12, p. 7.

It is respectfully asserted that instead of contributing to the claimed limitations recited by Claim 15, the _UPS_ and _FedEx_ references depict the problem that a user would face in trying to obtain comparison of shipping rates and delivery times and dates across multiple carriers and multiple delivery services offered by those carriers.

It is respectfully asserted that a user of _FedEx_ would encounter the description of _FedEx_ that different delivery times apply depending on the shipping particulars for shipping a particular parcel. For example, _FedEx_ explains that "FedEx Priority Overnight®" is for providing "...delivery by 10:30 a.m. the next business day to thousands of U.S. cities in our primary service are (noon to most of the rest)." _FedEx_, p. 1.

That is, in order for a _FedEx_ user to determine whether a parcel to be shipped using FedEx Priority Overnight® would result in delivery by 10:30 a.m. the next business day, or by noon the next business day (or some other time), the user would need to investigate whether the city to which the parcel was to be shipped was one of

the "thousands" for which delivery would be provided by 10:30 a.m., or whether the city was one of the "most of the rest" for which delivery would be provided by noon, or whether the city was neither one of the "thousands" for which delivery would be provided by 10:30 a.m., or one of the "most of the rest" for which delivery would be provided by noon, in which case, the FedEx reference provides no indication of a delivery time guarantee. Moreover, whatever the result of the user's above-outlined investigation, the time for delivery determined by the user would apply only if the user elected to use the FedEx Priority Overnight® delivery service; the user would need to plod on with further investigation to determine a comparison of a delivery time if the user were to instead, for example, elect FedEx Standard Overnight® or FedEx 2Day(SM).

The above-described steps that a *FedEx* user would have to take to determine the delivery time of a parcel to be shipped for any particular FedEx® service are evidence that *FedEx* does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Trying to obtain a comparison of projected delivery dates would also have required the *FedEx* user to investigate the specific FedEx® rules as those rules pertained to the user's particular shipping requirements. That is, the information provided in *FedEx* is only general information.

Regarding a date by which delivery would be expected, *FedEx* explains that Saturday delivery is not available for the "FedEx Standard Overnight®" service. *FedEx*, p. 1. That is, if a parcel is shipped on a Friday using FedEx Standard Overnight®, because delivery on Saturday is not available for that service, the parcel would not be delivered until the following Monday, or if the following Monday were a holiday, by the following Tuesday. Therefore, in order for a delivery *date* to be determined, a user of *FedEx* would need to consult a calendar (mentally or visually) to determine the delivery date on which a parcel shipped via, e.g., FedEx Standard Overnight® should be delivered. For example, if the user was shipping a package on, *e.g.,* a Friday, the user would need to identify the date of the following Monday, or if the following Monday were a holiday, the following Tuesday.

Yet further, in order for a delivery date to be determined, a user of _FedEx_, may, depending on the circumstances, need to consult a clock to determine the date of expected delivery of a parcel to be sent by FedEx Standard Overnight®. For example, if the user was shipping the package after a particular cut-off time, the package may not be delivered the following day -- that is, the package may be delivered two days after the shipment date.

The above-described steps that a _FedEx_ user would have to take to determine a delivery date of a parcel to be shipped, _e.g._, using FedEx Standard Overnight® are further evidence that _FedEx_ does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Further still, if a user of _FedEx_ wanted to compare, across various FedEx® services, delivery dates and times of a particular parcel that the user wanted to ship, the user would need to determine a delivery date and time for each FedEx® service to be compared. The aforementioned steps that a _FedEx_ user would have to take to determine a cross-comparison with an indication of delivery dates and times for a parcel using only a single carrier, _e.g._, FedEx®, is yet further evidence that _FedEx_ does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Turning to the _UPS_ reference, as with _FedEx_, _UPS_ teaches that, even for "guaranteed" services (_See, e.g., Office Action_, Topic 12, p. 5 (stating that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day.), different delivery times may apply depending on the shipping and/or delivery particulars for shipping and delivering a particular parcel. For example, for the UPS Next Day Air Early A.M.® delivery service, even though _UPS_ states "Guaranteed Overnight by 8 A.M.", _UPS_ clarifies that "[y]ou get guaranteed delivery by 8:00 a.m. to major U.S. cities and by 8:30 a.m. to _most_ other U.S. cities (9:00 a.m. or 9:30 a.m. on Saturday)..." (emphasis added). That is, in order for delivery to be "Guaranteed Overnight by 8 A.M.", assuming the delivery was to occur Monday through Friday, the delivery address would need to be in one of the "major U.S. cities;" in order for delivery

to be guaranteed by 8:30 a.m., the delivery address, if not in one of the "major U.S. cities", would need to be in one of the "*most* other U.S. cities..." (emphasis added).

As another example of guarantee-dependency on shipping particulars, for the UPS Next Day Air® delivery service, even though *UPS* states "Guaranteed Overnight by 10:30 AM", *UPS* clarifies that delivery is guaranteed "...by 10:30 a.m., noon, or end-of-day the next business day *depending on destination* (noon or 1:30 p.m. on Saturdays)." (emphasis added). That is, according to *UPS*, delivery time would be dependent on the destination address and the day of the week shipped.

Further, the *UPS* reference teaches that, notwithstanding the name of a delivery service, delivery guarantees may depend on the day of the week on which shipping occurs. For example, some UPS® delivery services support Saturday delivery; whereas others do not; Sunday delivery options are not indicated in *UPS* for any of the UPS® delivery services. *Compare, e.g., UPS*, p. 2 (describing, for UPS Next Day Air Early A.M.®, both a Saturday Delivery option and a Saturday Pickup option) and *UPS*, p. 4 (describing, for UPS Next Day Air®, both a Saturday Delivery option and a Saturday Pickup option), *with UPS*, p. 6 (describing, for UPS® 2nd Day Air A.M.®, a Saturday Pickup option, but with no mention of a Saturday Delivery option).

That is, assuming that the delivery address is to one of "most metropolitan addresses" to which delivery would be "Guaranteed Two-Day by 12 Noon" (*see, UPS*, p. 6), if a package were sent on a Thursday via UPS® 2nd Day Air A.M.®, even though the delivery service name "UPS® 2nd Day Air A.M.®" may imply that the delivery would be made by the second day, a Saturday, following the Thursday shipment day, according to *UPS*, Saturday delivery would not be available. Because a Saturday delivery option is not available for the "UPS® 2nd Day Air A.M.®" delivery service, then delivery for a package sent on a Thursday using the "UPS® 2nd Day Air A.M.®" delivery service would not be available until the next day available for deliveries for the "UPS® 2nd Day Air A.M.®" delivery service -- which, because neither Saturday nor Sunday are indicated in *UPS* as delivery days for the "UPS® 2nd Day Air A.M.®" delivery service, would therefore not occur until, *e.g.*, the following Monday, or if the following Monday were a holiday, then possibly not until the following Tuesday.

The above-described variations in delivery days and times for various UPS® delivery services as dependent on specific shipping and/or delivery parameters is evidence that the mere listing of a delivery service by name, and/or a general statement of guarantee, are not a conclusive indication of a delivery date or time for a particular parcel to be shipped to a particular address.

The *UPS* reference shows a "Quick Cost Calculator" link on each separate UPS® delivery service website page. For example, for the UPS Next Day Air Early A.M.® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air Early A.M." *UPS*, p. 2. As another example, for the UPS Next Day Air® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air." *UPS*, p. 4. As a further example, for the UPS 2nd Day Air A.M.® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air A.M." *UPS*, p. 6. Yet further, for the UPS 2nd Day Air® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air." *UPS*, p. 8. For the UPS 3 Day Select® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 3 Day Select." *UPS*, p. 10. For UPS Ground, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Ground Service." *UPS*, p. 12.

It is respectfully submitted that, even once a *UPS* user had obtained a set of rates and delivery dates and times for various delivery services offered by UPS®, doing so would not have provided the *UPS* user with rates and delivery dates and times, for various delivery services offered by any other carrier.

Further still, it is respectfully asserted that *Kara* does not compensate for the elements missing from the other cited references. As compared to the combination of limitations claimed by Claim 15 (and the Claims on which it depends), *Kara* discloses a system that requires that a user first pre-select a class and/or delivery "urgency". FIG. 7 of *Kara* depicts process element 712 that is labeled "Class/Urgency" and that contains

the description "Select from different choices: first, third, fourth, bulk rate, priority mail, air mail, same day, overnight, next day, 2 days, 3 days". FIG. 8 of _Kara_ depicts a display interface with a box 802 providing fields for Weight (Pounds and Ounces), Zone, Class, and a choice of Domestic or International. FIG. 8 of _Kara_ also depicts a box 807, labeled as "Urgency" and containing the choices of "Same day", "Overnight", "Next day", "2 Days", "3 Days", and "Immaterial". The specification of _Kara_ explains that, "[i]n step 712, the user selects the class and/or urgency of the item from the choices shown in box 802 and 807. It shall be appreciated that ones of the selections of class and urgency may substantially overlap and, therefore, selection of such an option from one of boxes 802 or 807 may also make a corresponding selection in the other one of boxes 802 or 807." _Kara_, col. 21, lines 1-7.

Kara discloses that "class and urgency information may be different for each of the shipping service providers and, accordingly, selection of a particular class[ ] or urgency criteria may be based at least in part on the particular shipping service provider(s) for which the user wishes the ... program to calculate the necessary postage.... Alternatively, the class and urgency information may be presented for selection generically, as shown in FIG. 8, and the ... program operate to determine the corresponding fees for each of the particular shipping service providers automatically." _Kara_, col. 21, lines 8-20.

Whether the class and urgency information available for selection by the user is presented "generically" (as depicted in FIG. 8 of _Kara_), or is available for "selection ... based ... on the particular shipping service provider", _Kara_ explains that, only after a selection of class and/or urgency is made are fees calculated and displayed.

> In order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship the piece of mail or other item, the E-STAMP program may calculate the fees associated with a plurality of the available shipping service providers. Accordingly, the user may select shipping service providers of interest (not shown) in order to allow the E-STAMP program to determine the fees for only those shipping service providers. Thereafter, the E-STAMP program may calculate and display fees associated with shipping the item via the selected shipping service providers according to the desired shipping and/or delivery parameters, i.e., class, urgency, etc. Where a selected shipping service provider does not provide a desired shipping and/or

> delivery parameter, the E-STAMP program may indicate such and provide the
> fees for a service offered by that particular shipping service provider most near
> that desired by the user.
>
> However, in the preferred embodiment, the E-STAMP program automatically
> calculates the fees for each shipping service provider offering service
> commensurate with the desired shipping and/or delivery parameters.
> Additionally, the E-STAMP program may indicate other ones of the shipping
> service providers which do not provide a desired shipping and/or delivery
> parameter and provide the fees for a service offered by that particular shipping
> service provider most near that desired by the user, as well as indicate how their
> service differs from that desired.

Kara, col. 22, lines 20 – 48.

FIG. 8 of *Kara* depicts box 808 which is labeled "Selection & Comparison". In
box 808 of FIG. 8 of *Kara*, the carriers "US Post", "Federal Express", "DHL", "UPS",
"Purolator", and "Emery" are listed. To the left of each carrier is a box, with which to
select one of the carriers. See *Kara*, col. 22, lines 53-54 ("...the user selects a
particular shipping service provider, such as by checking a box associated therewith
(shown in box 808) ..."). To the right of each carrier (shipping service provider) in box
808 is a dollar field for display of a shipping rate. *Kara*, FIG. 8. Importantly, only one
dollar field is indicated per carrier.

It is respectfully asserted that there is no teaching or suggestion as required
under MPEP §706.02(j), to combine *Barnett* with the other cited references. See *also*
MPEP §2143. In particular, it is respectfully submitted that *Barnett* is not in any way
related to product returns, shipping, or calculating rates.

According to the Office Action, "[i]t would have been obvious to ... to display the
calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a
plurality of cells with date on one axis and time on another, as disclosed by Barnett, in
order to provide a multi-layers system wherein different categories can be overlaid on
one another providing a single integrated display that allows a user to order or purchase
a system based on the calendar day and time ..." (citing Barnett, col. 2). Office Action,
Topic No. 12, p. 7.

It is respectfully submitted that "... provid[ing] a multi-layered calendaring system wherein *events belonging to different categories* and selected by a user can be overlaid on one another in a single integrated calendar ..." (as disclosed in *Barnett*, col. 2, lines 26 – 29 (emphasis added)), does not provide any teaching or suggestion as required by MPEP §§706.02(j) to combine *Barnett* with the other cited reference with respect to the subject matter of *e.g.*, Claim 15, which recites:

> ...wherein each of said cells comprises an intersection that coincides with a delivery date and a delivery time, and wherein each respective shipping rate is displayed in a respective cell that coincides with an intersection of a particular delivery date and a particular delivery time by which a particular delivery service by a particular carrier would deliver the particular respective item of merchandise to the particular online merchant for the respective shipping rate relevant to a particular shipping date.

In particular, it is respectfully asserted that Claim 15 is directed to a display of rates by various delivery services and various carriers for a *single event, i.e.*, "...deliver[ing] the particular respective item of merchandise to the particular online merchant ...". Therefore, it is respectfully asserted that *Barnett* is not properly combined with the other cited references and that, therefore, Claim 15 of the present application is non-obvious in view of the references of record and is in condition for allowance.

Yet further, it is respectfully submitted that *Barnett* does not disclose any display of rates by the *Barnett* system.

The subject matter of *Barnett* is calendaring, not rates. More specifically, *Barnett* discloses a "... computer-implemented method and system for generating and displaying a calendar containing user-selected events from user-selected categories." *Barnett*, Abstract. Figure 9 of *Barnett* displays a user-customized week-view calendar of events. According to the disclosure of *Barnett*, the week-view calendar of events reflects a user's selection of categories of events. *See Barnett*, FIG. 9; *Barnett*, col. 12, lines 16-21. Figure 8 of *Barnett* shows a month-view of a user-customized calendar. *See Barnett*, FIG. 8; *Barnett*, col. 11, lines 36-38. Figure 10 of *Barnett* shows a day view. *See Barnett*, FIG. 10; *Barnett*, col. 12, lines 42-43. None of the various calendars depicted in *Barnett* depict any display of rates. Moreover, there is simply no disclosure

in any of the Figures of _Barnett_, or in the disclosure of _Barnett_, that prices for the various calendared events are displayed in any of the _Barnett_ calendars or schedules.

It is true that _Barnett_ discloses that "[o]nline purchasing and related actions can be associated with each event" (_Barnett_, Abstract). However, _Barnett_ explains that the referred-to purchases would be done using links. _See, e.g., Barnett_, col. 2, lines 65-67 ("In addition, purchases of products, services, or tickets can be effected using links associated with displayed events."); _see also, e.g., Barnett_, col. 14, lines 13-17 ("In another embodiment, a link may be provided for making a purchase associated with a particular event. For example, if the event is a concert, a link to an on-line ticketing service maybe provided, for purchasing tickets to the concert."). It is respectfully submitted that the absence from the disclosure of _Barnett_ of a display of price for a calendared event, and the disclosure of _Barnett_ that a link to a separate service may be provided for making a purchase associated with a calendared event are evidence that _Barnett_ did not contemplate that the system of _Barnett_ would itself associate a price with an event calendared by the _Barnett_ system.

Further, even assuming for the sake of argument that it could be argued that _Barnett_ somehow suggested showing rates, it is respectfully asserted that the rates that _Barnett_ might display would be for the various events calendared, not as a cross-comparison of rates for a single event such as the single event of a shipment of a return item to which Claim 15 (and the Claims on which Claim 15 depends) are directed.

Yet further, as compared to the limitations recited by Claim 15, it is respectfully asserted that FIG. 9 of _Barnett_ discloses a display of an identification of a pre-scheduled event at an intersection that coincides with a pre-scheduled date and time for the particular event. That is, _Barnett_ does not determine a schedule for an event. Rather, the events that are displayed by _Barnett_ have already been pre-scheduled.

As distinguished from the display of pre-scheduled events in _Barnett_, it is respectfully asserted that an exemplary embodiment of the limitations of Claim 15 would result in a customized display of rates that would be calculated and displayed on a schedule of delivery dates and delivery times that would be determined relevant to a particular shipping date, according to the parameters of the particular item being

returned, and according to pricing rules for the particular carriers that had been pre-selected by a merchant.

For the above-given reasons, it is respectfully submitted that even assuming for the sake of argument only, that *Barnett* discloses rates, the combination of *Kara*, *Barnett*, *UPS* and *FedEx* would not result in the combination of limitations recited by Claim 15 (and the Claims on which it depends).

Accordingly, it is respectfully asserted that Claim 15, and the Claims that depend on Claim 15, namely, Claims 16-21, are therefore patentably distinct from, and patentable over, the combination of *Barnett* with *UPS*, *FedEx* and *Kara* (and for the reasons described above for Claim 1, from *Schwab*, *Seigel* and *Junger*), and are in condition for allowance.

CONCLUSION

For the above-given reasons and for the authorities cited above, it is respectfully asserted that none of *Schwab*, *Siegel*, *Kara*, *Junger*, *UPS*, *FedEx*, *Barnett*, or any other reference of record, whether considered alone or in combination, disclose, anticipate, teach or suggest all of the limitations of the rejected Claims.

Therefore, for the foregoing reasons, it is respectfully asserted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination and that the application is in condition for allowance. Accordingly, it is respectfully requested that the present application be reconsidered and allowed.

Respectfully submitted,
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